

## **REMARKS**

Upon entry of the present amendment, the claims in the application are original claims 1-

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### ***Rejections Under 35 USC 103***

Applicant respectfully traverses the 35 USC 103 rejections.

#### **CLAIM 1: -**

The OA rejects claim 1 as being unpatentable over Blommerde in view of Latassa.

Applicant submits that, in contrast, Blommerde teaches that a metal container is held in the exhaust tube by a constriction in the container and an indentation in the exhaust tube corresponding thereto. The container with mercury is present in the exhaust tube and serves as a constant source of liquid mercury inside of the lamp. During transport and during and after the pumping process, the container **will remain in its place in the exhaust tube**. The exhaust tube is only a part of an inner space of lamp and a place of fixation of the metal container. Such method does **not** provide or **even suppose** a **direct introducing** of vapor by the intense evaporation of the liquid mercury from outside of the lamp. The container with a liquid mercury in the known method should be considered as an integral part of the lamp.

The OA concedes that Blommerde does not disclose the metal container containing a mercury-filled glass capsule, or an opening in the metal container, or that the heating should be performed by a high-frequency induction method.

The OA further concedes that Blommerde does **not** disclose the separation of the remaining portion of the exhaust tube from the lamp.

However, the OA contends that it would have been obvious to the artisan to re-engineer the Blommerde **lamp** with selective features of the Latassa **dispenser** to arrive at applicant's **method** as specified in claim1.

In contrast, applicant's specification para. 8 explains that Latassa proposes to place the capsule **within the arc discharge lamp tube**, inside a protective shield made of glass or metal; and that mounting of such capsules **within the working area of arc discharge lamp tube** is rather complicated, and the process of operation does **not** exclude a damage to the internal structure of the arc discharge lamp tube.

It is also important to note that Latassa discloses using the container with a liquid mercury **which is also is an integral part of the electrode inside of the lamp**.

Furthermore, the Latassa container also can **not** be used to receive a directional flow of pure mercury vapor which flow fills up the inner space of the lamp (as required by applicant's claim1).

Also, due to the long duration of the heating effect, Latassa inevitably results in mercury oxidation and therefore its excessive consumption.

Indeed, none of the prior art references, taken singly or in combination, permits to establish an environmentally safe production and to carry precise metering of introduced mercury without resorting to utilization of excessive amounts.

The OA alleges that it would have been obvious to use the teachings of Latassa in the "method" of Blommerade (actually teaches an **apparatus**, not a **method**), by replacing the container of Blommerade with the container and capsule of Latassa such that an opening is in the direction of the internal space of the lamp, since the mercury dispenser of Latassa is easier to handle than an all-metal dispense.

Applicant respectfully traverses this.

In contrast, applicant submits that:

1) a prima facie case of obviousness has not been made;

2) this modification suggested by the OA **must be suggested by the prior art**, and **not by the Examiner** after reading applicant's disclosure; and

3) this modification suggested by the OA violates current holdings of the CAFC.

For example, in a wide-ranging decision rendered in a case that had previously been before the U.S. Court of the Federal Circuit, the Court this time affirmed a jury instruction that **a modification is not obvious** unless **the prior art suggests** the desirability of the modification. *Cordis Corp. v. Medtronic AVE, Inc. and Boston Scientific Corp*, Case Nos. 06-1393, -1394, -1395, -1396, -1415, -1416 (*Fed. Cir.*, Jan. 7, 2008) (*Bryson, J.*).

Although Medtronic AVE agreed with the jury instruction on obviousness at trial, on appeal it challenged the instruction to the jury on obviousness. The jury was instructed that “a suggestion to combine references may also flow from the nature of the problem or from the ordinary knowledge of those skilled in the art that certain references are of special importance. If the prior art references as a whole do not teach, suggest or motivate that combination, then **they may not be combined**. The **mere fact that the prior art can be modified** does not make the modification obvious **unless the prior art suggests the desirability of the modification**.”

Furthermore, a **prima facie** case of obviousness is a procedural tool, which, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion that the OA seeks, but **also** that the prior art **compels** such a conclusion if applicant produces **no** evidence or argument to rebut it. *In re Spada*, 15 USPQ 2d 1655, 1657 (CAFC 1990).

In addition, the fact that none of the objects of the invention enumerated in applicant's specification have been satisfied by the applied prior art is germane to a conclusion of non-obviousness. Vollrath Co. v. Premium Plastics, Inc., 183 USPQ 335, 338.

Applicant respectfully submits that the genius of invention is often a combination of known elements, which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. Gambro Lundia AB v. Baxter Healthcare Corp, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

The opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. In re Dembiczak, 175 F. 3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); In re Gartside, 203 F.3d 1305, 53 USPQ 2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

Whether a motivation to combine prior art references has been demonstrated is a question of fact. Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000).

It is impermissible for the Examiner to first ascertain factually what applicant did, and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. In re Shuman, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966).

The test to be applied is whether the claimed invention would have been obvious to one skilled in the art when the invention was made, not to an Examiner after learning all about the invention. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed.

Cir. 1983).

Inventions must be held to be nonobvious where neither any reference, considered in its entirety, nor the prior art as a whole, suggested the combination claimed. *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 932-33 (Fed. Cir. 1984).

Nowhere does the OA indicate where in the prior art there might be a suggestion of combining teachings of the individual references, or how, if there was such a suggestion, such combination would equal the invention claimed by applicant.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438.

In light of the foregoing, applicant respectfully submits that the OA has failed to make a prima facie case of obviousness with respect to claim 1.

**CLAIM 3: -**

The OA rejects claim 3 as being unpatentable over Blommerde in view of Latassa.

There is incorporated hereat the distinctions, case authorities, and arguments set forth hereinabove with respect to claim 1, which apply with even greater force to claim 3 that depends from and defines a more limited species of the claim 1 invention.

**CLAIM 2: -**

The OA rejects claim 2 as being unpatentable over Blommerde in view of Latassa, and further in view of Wittmann.

The OA concedes that Blommerde in view of Latassa is silent regarding the amount of

Hg contained in the glass capsule.

There is incorporated hereat the distinctions, case authorities, and arguments set forth hereinabove with respect to claim 1 which apply with even greater force to claim 3 that depends from and defines a more limited species of the claim 1 invention.

In light of the foregoing, applicant respectfully requests reconsideration of the 35 USC 103 rejection of the previously-allowed claim 21 with a view to withdrawing same.

**CLAIM 4:-**

The OA rejects claim 4 as being unpatentable over Blommerde in view of Latassa, and further in view of Cassidy.

The OA concedes that Blommerde in view of Latassa is silent regarding the power of the heating unit.

However, to be complete and accurate the OA should state that Blommerde in view of Latassa is silent regarding (providing in the context of the claim 1 invention) “the local electromagnetic radiation is provided by a high-frequency induction heating unit having a power rating within the range from about 500 W to about 1 kW” as specified in claim 4.

The OA alleges it would have been obvious: to use “the time” of Cassidy in “the modified **method** of Blommerde”, since this would rupture the capsule without completely shattering it, which might result in particles small enough to escape the metal container; and to understand that the amount of power applied to rupture “the modified **capsule** of Blommerde” in 3 seconds is comparable to that needed to rupture the “similar” Applicant’s capsule in 1-5 seconds, and thus the use of a RF induction unit having a power rating from about 500 W to about 1 kW would be similarly obvious.

In contrast, applicant's specification para. 7 states that Cassidy discloses: the use of glass capsules that contain mercury **and are fastened on an auxiliary electrode inside the tube working area**; a capsule was heated by high-frequency effect, thereby resulting in glass cracking and hence the release of mercury vapor; **due to the long duration of the heating effect, such technology inevitably results in mercury oxidation and therefore its excessive consumption**; and, in addition, **implementation of Cassidy requires special electrodes of a complicated design**.

Furthermore, there is incorporated hereat the distinctions, case authorities, and arguments set forth hereinabove with respect to claim 1, which apply with even greater force to claim 4 that depends from and defines a more limited species of the claim 1 invention.

**CLAIM 5: -**

The OA rejects claim 5 as being unpatentable over Blommerde in view of Latassa, further in view of Wittmann, further in view of Cassidy, and further in view of Holmes.

The OA concedes:

that Blommerde does not disclose the metal container containing a mercury-filled glass capsule,

nor an opening in the metal container,

nor that the heating should be performed by a high-frequency induction method, nor the separation of the remaining portion of the exhaust tube from the lamp;

that Blommerde in view of Latassa is silent regarding the amount of Hg contained in the glass capsule;

that Blommerde in view of Latassa and Wittmann is silent regarding the power of the heating unit; and

that Blommerde in view of Latassa, Wittmann, and Cassidy does not disclose the electron lamp being a neon tube.

These “**five**” cited references, taken singly or in combination, fail to teach or make obvious the invention as specified in claim 5.

In contrast to the rejection, applicant submits that:

- 1) a prima facie case of obviousness has not been made;
- 2) the **series of many modifications** suggested by the OA **must be suggested by the prior art**, and **not by the Examiner** after reading applicant’s disclosure; and
- 3) the **series of many modifications** suggested by the OA violates current holdings of the CAFC.

For example, in a wide-ranging decision rendered in a case that had previously been before the U.S. Court of the Federal Circuit, the Court this time affirmed a jury instruction that **a modification is not obvious** unless **the prior art suggests** the desirability of the modification. *Cordis Corp. v. Medtronic AVE, Inc. and Boston Scientific Corp, Case Nos. 06-1393, -1394, -1395, -1396, -1415, -1416 (Fed. Cir., Jan. 7, 2008) (Bryson, J.)*.

Although Medtronic AVE agreed with the jury instruction on obviousness at trial, on appeal it challenged instruction to the jury on obviousness. The jury was instructed that “a suggestion to combine references may also flow from the nature of the problem or from the ordinary knowledge of those skilled in the art that certain references are of special importance. If the prior art references as a whole do not teach, suggest or motivate that combination, then **they may not be combined**. The **mere fact that the prior art can be modified** does not make the modification obvious **unless the prior art suggests the desirability of the modification**.”

Furthermore, a **prima facie** case of obviousness is a procedural tool, which, as used in



patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion that the Examiner seeks, but also that the prior art compels such a conclusion if applicant produces no evidence or argument to rebut it. In re Spada, 15 USPQ 2d 1655, 1657 (CAFC 1990).

In addition, the fact that none of the objects of the invention enumerated in applicant's specification have been satisfied by the applied prior art is germane to a conclusion of non-obviousness. Vollrath Co. v. Premium Plastics, Inc., 183 USPQ 335, 338.

Furthermore, a prima facie case of obviousness is a procedural tool, which, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion that the Examiner seeks, but also that the prior art compels such a conclusion if applicant produces no evidence or argument to rebut it. In re Spada, 15 USPQ 2d 1655, 1657 (CAFC 1990).

Also, there is incorporated hereat the distinctions, case authorities, and arguments set forth hereinabove with respect to the cited references, which apply with even greater force to claim 5.

It is also important to note that the methods as specified in claims 1-5 **are universal, and a variety of electrodes may be used for providing mercury.**

In light of the foregoing, applicant respectfully requests reconsideration of the 35 USC 103 rejections with a view to withdrawing same.

Applicant also mentions that applicant's corresponding EP application (02805987.1) has been granted, and a copy of the granted EP claims is attached hereto.

***Conclusion***

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner is not convinced that the application is now in condition for allowance, it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable consideration is respectfully requested.

Respectfully submitted,

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